

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

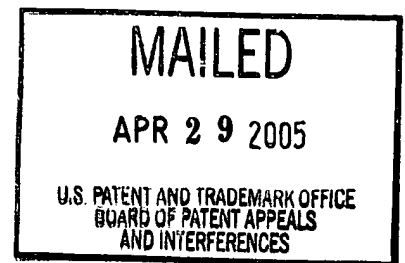
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Ex parte BERTHOLD FECTEAU et al.

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Application No. 09/877,188

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**ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER**

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This application was electronically received at the Board of Patent Appeals and Interferences on April 20, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On page 17, in the 2<sup>nd</sup> paragraph under the "Issues and Rejections" section of the Appeal Brief filed on June 9, 2004, applicants submit that, based on the agreement reached during the interview on January 15, 2004, claims 33-36, 88-91, 96-99, 105-108, and 119-121 are allowable. However, claims 34-36, 88-91, 96-99, 105-108, and 119-121 were never stipulated as being allowable by the examiner in the Interview

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Summary of January 15, 2004. Rather only claim 33 would be allowable. The Appeal Brief then goes on to state: "In the event that the Examiner's Answer rejects those claims, Appellants will address them in a Supplemental Reply Brief." This is not in compliance with 37 CFR 1.192 which requires that all of the claims on appeal be argued in the Appeal Brief.

The Examiner's Answer filed on September 30, 2004, is defective because it failed to clarify the status of the claims referred to above. Furthermore, under the section entitled "Prior Art of Record" there is a statement indicating no prior art is relied upon in the rejection of the claims. Thereafter, two references and the AAPA are clearly cited. Also, under the section of the Examiner's Answer entitled "Claims Appealed, " the examiner states: "A substantially correct copy of appealed claims . . . 96, 10-104 . . . appears on page 78 of the Appendix" to the Appeal Brief. It appears that it should have stated that a substantially correct copy of claims 100-104 appears in the Appendix. Moreover, claim 96 does not appear in the Appendix. Also, the copy of the claims actually starts on page 78 and not that all the claims just appear on page 78.

Moreover, under the section of the Examiner's Answer entitled "Issues," the examiner says the brief is correct, while the 3<sup>rd</sup> paragraph under the section entitled "Issues" in the Appeal Brief fails to give claim 49 as one of the claims on appeal.

Likewise, under the section entitled "Grouping of Claims" in the Examiner's Answer, the examiner fails to note that in the Appeal Brief claim 49 does not appear under the "Grouping of Claims." However, the claim is argued in the Appeal Brief on

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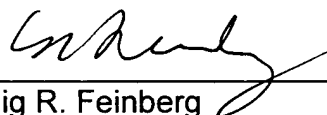
page 72, and it is included in the Appendix. Claim 49 is rejected under the "Grounds of Rejection" section of the Examiner's Answer.

Accordingly, it is

ORDERED that the application is electronically returned to the examiner to clarify the status of claims 34-36, 49, 88-91, 96-99, 105-108, and 119-121 and to correct the errors contained in the Examiner's Answer filed on September 30, 2004, as noted earlier, and for such further action as may be appropriate. Furthermore, if indeed all or a portion of claims 34-36, 88-91, 96-99, 105-108, and 119-121 are still under rejection, the Applicants should be given the opportunity to submit a revised Appeal Brief addressing the rejection of these claims.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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